



## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

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MAILED

APR 13 2007

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Applicants: Dahlberg et al.  
Application No.: 09/660,924  
Filed: 09/13/00  
For: Methods for modifying an  
oligonucleotide

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,521.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/ss/ Sally Gardner Lane  
SALLY GARDNER LANE  
Administrative Patent Judge

Paper 1

Mail Stop Interference  
P.O. Box 1450  
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Fax: 571-273-0042

Filed: April 13, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

LINDA M. WESTERN,  
SAMUEL J. ROSE, and  
EDWIN F. ULLMAN,

Junior Party  
(Patents 6,121,001 and 6,110,677),

v.

MAILED

JAMES E. DAHLBERG,  
MARY ANN D. LYAMICHEV, and  
VICTOR I. LYAMICHEV,

APR 13 2007

Senior Party  
(Application Patent 09/660,924).

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Patent Interference No. 105,521  
(Technology Center 1600)

DECLARATION - Bd.R. 203(b)<sup>1</sup>

1           Part A. Declaration of interference

- 2           An interference is declared (35 U.S.C. § 135(a)) between the above-identified  
3           parties. Details of the application(s), patent (if any), reissue application (if any),  
4           count(s) and claims designated as corresponding or as not corresponding to the  
5           count(s) appear in Parts E and F of this DECLARATION.

<sup>1</sup> "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1           **Part B. Judge managing the interference**

2           Administrative Patent Judge Sally Gardner Lane has been designated to  
3 manage the interference. Bd. R. 104(a).

4           **Part C. Standing order**

5           A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
6 DECLARATION. The STANDING ORDER applies to this interference.

7           **Part D. Initial conference call**

8           A telephone conference call to discuss the interference is set for **2:00 p.m. on**  
9 **5 June 2007** (the Board will initiate the call).

10          No later than **four business days** prior to the conference call, each party shall  
11 file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd. R. 120; Bd. R. 204;  
12 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

13          A sample schedule for taking action during the motion phase appears as Form 2  
14 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to  
15 the conference call and to agree on dates for taking action. A typical motion period  
16 lasts approximately eight (8) months. Counsel should be prepared to justify any  
17 request for a shorter or longer period.

## **Part E. Identification and order of the parties**

## Junior Party

Named inventors: Linda M. Western  
San Mateo, CA

Samuel J. Rose  
Los Altos, CA

**Edwin F. Ullman**  
**Atherton, CA**

**Involved Patent:** 6,121,001, issued 19 September 2000  
based on application 09/440,363,  
filed 15 November 1999

**Title:** DETECTION OF NUCLEIC ACIDS BY TARGET-CATALYZED PRODUCT FORMATION

**Involved Patent:** 6,110,677, issued on 29 August 2000  
based on application 09/015,949  
filed 30 January 1998

**Title:** OLIGONUCLEOTIDE MODIFICATION, SIGNAL AMPLIFICATION, AND NUCLEIC ACID DETECTION

Assignee: Dade Behring Inc.

### Senior Party

Named Inventors: James E. Dahlberg  
Madison, WI

May Ann D. Lyamichev  
Madison, WI

Victor I. Lyamichev  
Madison, WI

Involved Application: 09/660,924, filed 13 September 2000

**Title:** METHODS FOR MODIFYING AN OLIGONUCLEOTIDE

**Assignee:** None available

16 The senior party is assigned exhibit numbers 1001-1999. The junior party is  
17 assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1); SO ¶ 154.2.1. The senior  
18 party is responsible for initiating settlement discussions. SO ¶ 126.1.

## **Part F. Count and claims of the parties**

### Count 1

22 The method of claims 1, 27, or 28 of Western 6,121,001 or the method of claims 1 or 5  
23 of Western 6,110,677 or the method of claim 112 of Dahlberg 09/660,924.

**The claims of the parties are:**

25 Western '001: 1-29

Western '677: 1-24

Western '677: 1-24

26 Western '677: 1-24

Western '677: 1-24

Dahlberg: 112-117

The claims of the parties which correspond to Count 1 are:

Western '001: 1-5, 27 and 28

Western '677: 1-11

Dahlberg: 112-117

The claims of the parties which do not correspond to Count 1, and therefore are

6 not involved in the interference, are:

## Western '001: 6-26 and 29

**Western '677:** 12-24

Dahlberg: None

The parties are accorded the following benefit for Count 1:

Western: US 09/015,949, filed 30 January 1998,<sup>2</sup>  
Issued as 6,110,677 on 29 August 2000

US 08/691,627, filed 02 August 1996,  
Issued as 5,792,614 on 11 August 1998

US 08/363,169, filed 23 December 1994.

Dahlberg: US 08/520,946, filed 30 August 1995,  
Issued as 6,372,424 on 16 April 2002

US 08/484,956, filed 07 June 1995,  
Issued as 5,843,654 on 01 December 1998

US 08/402,601, filed 09 March 1995

US 08/254,359 ('359), filed 6 June 1994,  
Issued as 5,614,402 on 25 March 1997<sup>3</sup>

2 As to the '001 patent.

3 The examiner recommended that Dahlberg be accorded priority benefit of the '359 application. (See attachment to Form 850). According to interference practice specialist Cecilia Tsang of Technology Center 1600, the '359 file can no longer be located. Dahlberg is accorded benefit of the '359 application contingent on Dahlberg filing and serving a complete copy of the '359 application file within the time set. (See Order (Paper 3)).

1 US 08/073,384, filed 4 June 1993,  
2 Issued as 5,541,311 on 30 June 1996  
3

4 US 07/986,330, filed 7 December 1992  
5 Issued as 5,422,253 on 6 June 1995  
6

7 **Part G. Heading to be used on papers**

8 The following heading must be used on all papers filed in this interference, see  
9 SO ¶ 106.1.1:

10 UNITED STATES PATENT AND TRADEMARK OFFICE

11 \_\_\_\_\_  
12  
13 BEFORE THE BOARD OF PATENT APPEALS  
14 AND INTERFERENCES

15 \_\_\_\_\_  
16 LINDA M. WESTERN,  
17 SAMUEL J. ROSE, and  
18 EDWIN F. ULLMAN,

19 Junior Party  
20 (Patents 6,121,001 and 6,110,677),  
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22 v.  
23

24 JAMES E. DAHLBERG,  
25 MARY ANN D. LYAMICHEV, and  
26 VICTOR I. LYAMICHEV,  
27

28 Senior Party  
29 (Application Patent 09/660,924).  
30

31 \_\_\_\_\_  
32 Patent Interference No. 105,521  
33 (Technology Center 1600)  
34

1           **Part H. Order form for requesting file copies**

2       When requesting copies of files, use of SO Form 4 will greatly expedite  
3       processing of the request. Please attach a copy of Parts E and F of this  
4       DECLARATION with a hand-drawn circle around the patents and applications for which  
5       a copy of a file wrapper is requested.

/Sally Gardner Lane/  
Administrative Patent Judge

Enc:

Copy of STANDING ORDER  
Copy of Form 850  
Copy of claims of U.S. Patents 6,121,001 and 6,110,677  
Copy of claims of US 09/660,924  
Copy of default time schedule

Revised 3 January 2006

cc (via overnight delivery):

Attorney for Western:

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